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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,222	02/09/2001	Andrew M. Schwarzbauer	38916/24384	5359

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 05/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/780,222

Applicant(s)

SCHWARZBAUER ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15 is/are rejected.
- 7) ☒ Claim(s) 10-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Response to Amendment***

1. After further consideration, the finality of the rejection of the last Office action has been withdrawn. Claims 1-20 are now rejected using new prior art.

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***Terminal Disclaimer***

2. The terminal disclaimer filed on March 17, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,352,287 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the featured limitation of a “breakaway layer... within the periphery of the primary film”, as stated in Claim 1, line 6, must be shown or canceled from the claim. Furthermore, the limitation of a base paper layer and secondary film layer having a periphery adhesively bonded wherein the die cut information card consisting only of the “base paper layer, secondary film layer and the breakaway layer”, as stated in Claim 2, lines 11 and 12, must also be shown or the feature(s) canceled from the claim. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (6,328,340).

Fischer discloses in Fig. 3a and 3b, a form with an integrated card comprising: a primary film (21) having top and bottom surfaces and a periphery; a breakaway layer (22) constructed of translucent urethane acrylic, and capable of accepting printed indicia (Col. 5, lines 20-25) and disposed between the primary layer (21, wherein the breakaway layer is adhesively coated on top) and a secondary layer (28); a die-cuts (31); and a base paper layer (1) having top and bottom surfaces; an adhesive layer (27) that secures the base paper layer (1) to the breakaway layer; and an information card comprised of the die-cut base paper (1), adhesive layer (27), and the breakaway layer (22); and wherein the breakaway layer has a greater affinity for the adhesive layer than the top surface of the primary film layer such that when the card is removed, the breakaway layer stays adhered to the bottom surface of the adhesive layer.

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However, Fischer does not disclose: a breakaway layer composed of a material having a thickness that varies at different points along the primary film layer; a breakaway layer having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer; .

In regards to **Claims 1 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the various release levels of the breakaway layer at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the breakaway layer of any desirable material that varies in thickness at different points, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the die-cuts at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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5. Claims 1-9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steidinger et al (6,350,342).

Steidinger et al discloses in Fig. 4, a form with an integrated card comprising: a primary film (35) having top and bottom surfaces and a periphery; a breakaway layer (37) directly and removably bonded to the primary film layer (35); a secondary film layer (38) bonded to the breakaway layer (37); a die-cuts (33); and a base paper layer (31) adhesively bonded (adhesive 38) to the secondary film layer; and an information card consisting of the die-cut base paper (31), secondary film layer (38), and the breakaway layer (37); wherein the breakaway layer is removably bonded to the primary film layer and permanently bonded to the secondary film layer.

However, Steidinger et al does not disclose: wherein the breakaway layer is composed of a material having a thickness that varies at different points along the primary film layer: a breakaway layer having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer.

In regards to **Claims 1 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the various release levels of the breakaway layer at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the breakaway layer of any desirable material that varies in thickness at different points, since it has been held to be within the general skill of a

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worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the die-cuts at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

#### ***Allowable Subject Matter***

6. Claims 10-14 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Stewart and Steidinger et al disclose a form with an integrated card.



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***Response to Arguments***

7. Applicant's arguments with respect to claims 1-9 and 15 have been considered but are moot in view of the new ground(s) of rejection.


**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

April 28, 2003



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